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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/138,926	08/24/1998	FRANK C. CESARE	D-6362	4707
6449	7590	12/09/2004	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			RAYFORD, SANDRA M	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/138,926

Applicant(s)

CESARE

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-28 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claims***

1. Claims 14-28 and 30 are pending. Claims 1-13 and 29 have been cancelled.
2. The examiner regrets any inconvenience caused by her failure to mention claim 30 in the 24 March 2004 office action.

### ***Withdrawal of Allowance***

3. The allowance of claims 14-28 is hereby withdrawn in order to apply the new ground of rejection set out below.

### ***Rejections Withdrawn***

4. The 35 USC 102 rejection of claims 1-11 as anticipated by Toyosawa et al (EP-0 699 710 A2), as set out in section 9 of the 24 March 2004 office action ("the last office action"), is withdrawn in view of the amendments in 21 September 2004 response ("the last response").
5. The 35 USC 103 rejection of claims 12-13 as unpatentable over Toyosawa, as explained in section 10 of the last office action, is withdrawn in view of the amendments in the last response.

### ***New Rejections***

#### **Claim Rejections - 35 USC § 102**

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 14, 21-23 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Liu (US 4,564,658).

Liu teaches articles (col. 9, lines 53-58) from molding compositions (title) containing high molecular weight polyester (col. 2, line 32), glass fibers (col. 7, line 57) and ethylene/propylene copolymers (col. 5, lines 25-40). The copolymers read on applicants' because they contain 1-20% propylene (col.5, lines 25-30) and applicants' ethylene content must be 80% or less so that the sum of the ethylene and propylene contents is 100% (see lines 14-15 of claim 14).

The resins are solids because they are dry blended (col. 9, line 3).

The properties of claims 21 and 22 are inherent because Liu uses applicants' claimed materials and applicants' claimed amounts.

#### Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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9. Claims 14-28 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of U.S. Patent No. 4,843,128 (to Cesare) in view of JP 03268942A (based on its abstract).

Cesare, in claim 1, teaches elastomeric compositions containing rubber (claim 1, lines 3-4; claim 7, line 3 recites natural rubber) and ethylene/propylene/nonconjugated diene terpolymers with molecular weights of 500 to 15,000 (claim 1, lines 9-12).

It fails to claim the fibers or the articles recited in applicant's claims or the properties of claims 21-22.

The Japanese abstract teaches that v-belts, belts, hoses and diaphragms (use/advantage section) can be made from compositions containing chloroprene rubber (second paragraph), and aramid fiber (use/advantage section).

The references are analogous because they both deal with rubber articles.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the aramid fiber of the Japanese abstract along with the resins components in the Cesare patent to produce belts, hoses and diaphragms, as suggested by the Japanese abstract.

The motivation to employ the aramid fiber of the Japanese abstract in the compositions of Cesare is found in the use/advantage section of the Japanese abstract, where its composites are taught to be bonded to aramid fibers in belts, hoses and diaphragms.

It is deemed desirable to make belts, hoses and diaphragms using aramid reinforcement in order to extend their useful lives.

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The selection of ethylene/propylene/nonconjugated polyene terpolymers having suitable molecular weights for use in the Cesare compositions, as recited in applicants' claim 21, is deemed a matter of engineering choice.

The penetration properties of the ethylene/propylene/nonconjugated polyene terpolymers of the Cesare patent would be expected to be comparable to those recited in claim 22 since the terpolymers are the same as those claimed here.

Response to Arguments

10. Applicant's arguments with respect to claims 14-28 and 30 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.

*S. M. Nolan-Rayford*  
S. M. Nolan-Rayford  
Primary Examiner  
Technology Center 1700

09138926(20041207)